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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215734
Party	Defendant The Solution Group Corp
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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Assa Realty, LLC

Opposer,

v. Opposition No. 91215734

The Solution Group Corp.

Applicant,

_____)

APPLICANT'S RESPONSE TO OPPOSER'S
MOTION FOR SUMMARY JUDGMENT

There are several issues of material facts that need to be resolved at trial, including those related to the alleged priority claimed by the movant and the likelihood of confusion with those services for which there could be some use support, albeit speculative at best.

1. Movant's claimed priority.

Applicant filed its application for the mark CASSA and Design on April 10, 2013 for real estate development and construction of commercial, residential and hotel property. Opposer filed an application subsequently for the same mark CASSA on June 10, 2013. To support its priority claim the movant relies on alleged prior use of the designation CASSA. Opposer relies on its principal's testimony and some exhibits purporting to show a date of use in commerce prior to Applicant's filing date. However, the use allegations are insufficient to provide a Section 2(d) basis for priority that would confer movant a superior service mark right, or alternatively, there are unresolved issues of material facts that cannot be overcome with the motion *sub judice*.

Opposer's only affidavit to support its prior use is replete with hearsay and speculative statements. While the affidavit itself is hearsay, it should at least be based on assertions based on the affiant's personal knowledge. That is not the case with Salim Assa's affidavit (hereinafter referred to us Aff. ¶ _)

With respect to the adoption of the mark, Affiant makes several unsupported assertions. Aff. ¶ 5. Exhibit 14 purports to be an email sent on January 16, 2007 to several individuals relating to the adoption of the term CASSA. Affiant claims to have been one of those individuals but his email address is not identified. More important, there is no mention of Opposer, ASSA REALTY, LLC, anywhere in Exhibit 14. How the purported adoption could inure, somehow, to the benefit of Opposer is not shown. Lastly, there is no support for the last sentence ("In this way people would know it was us") and it is, at best, hearsay and speculative.

The purported licensing arrangement[1] between the Opposer and several other entities is enigmatic, at best. Aff. ¶ 6.

Affiant states that it first used the mark CASSA by March 15, 2009. Aff. ¶ 7, first sentence. However, the third sentence belies any technical use since the displays and signs with the Mark provided a connection to an entity, and did not advertise services.

> "A showroom was opened around the corner from the W45 Project in which we exhibited displays and signs using the Mark and its connection to **us**." Aff. ¶ 7, 3rd sentence, *emphasis added.*

It is clear that the displays and signs did not advertise a service but rather an entity, purportedly a related entity of Opposer.

[1] Since no documents have been produced relating the purported licensing agreement, it is assumed that it is an ephemeral oral agreement between the Affiant and himself. However, there is no indication that the Affiant's authorization to Waterscape Resort, LLC was made on behalf of the Opposer.

Next, the allegation that the CASSA mark was advertised in the New York Times does not have documentary support and is admitted in footnote 3 of the Affidavit. The copies of artwork identified as Exhibits 16; 17 and 20 do not show use in commerce, or any kind of use for that matter. If anything, these exhibits belie the abovementioned assertion of first use on March 15, 2009 since it is clear that in April 2009 the artwork had not been the subject of any advertisement.[2] Aff. ¶ 7.

Also, it should be noted that Movant did not disclose the purported advertisement in its answer to Applicant's interrogatory Nos. 7; 10. See Movant's Exhibit 6. Opposer had been asked in those two interrogatories to identify documents and state the media (i.e. newspaper, etc.), respectively, used to promote the Mark. In its answers there was no mention of advertising in the New York Times.

The testimony relating to the use of the mark in the websites is contradictory at best. Affiant states: " At the same time, a website was launched . . . " Aff. ¶ 7, sixth sentence. Paragraph 7 starts with " By March 15, 2009 . . . " *id.* However, Exhibit 38 (Bates No. AR0357) is a June 2009 email stating that the Cassa Website was "unfinished" and "not working" yet. *id.*

There are material questions as to whether the website was in actual operation or not at the time. And, equally important, whether the use inured to the benefit of Opposer indirectly through the purported licensee. Or, whether Waterscape Resort LLC was the owner of the mark and the license agreement was an afterthought for this controversy. In fact, Opposer's pleadings also contradict Affiant's position since the license agreements existed from 2012 (and not 2009 as now alleged in the affidavit). See Notice of Opposition, ¶ 18 [D.E. 1].

[2] Exhibits 16 and 17 discuss advertising pricing. So, it is clear that the alleged advertising had not taken place by April, 2009. Exhibit 20 is merely an artwork and it does not refer to the Opposer nor its purported licensee, at the time (whether the license agreement had been dreamed up by then or not).

Furthermore, it appears that Opposer abandoned any rights it may have had over the CASSA designations when it permitted the purported licensee, Waterscape Resort, LLC to "license the Mark to 70 West 45 Street Holding, LLC so the new owners could continue operating the hotel as CASSA Hotel." Aff. ¶ 9. This was done in the context of a bankruptcy proceeding under Chapter 11 requiring the disappearance of the "licensor". It is not possible for the licensor to retain the power to control the quality of the nature or quality of the services rendered by the licensee after that. Thus, the mark CASSA was abandoned in April, 2011.

Affiant next alleges "the Mark has been continually used without interruptions . . . " Aff. ¶ 11. The statements and documents referred to in this paragraph do not support Affiant's proposition.

a. The 2011 New York publication, Exhibit 15, mentioning the concierge of Cassa Hotel and Residences is not evidence of use of a service mark, as defined in 15 SC 1145. No services are offered in the publication.
b. And with respect to Exhibit 18, a purported publication in a Croatian magazine, with no dates of publication or any indication that the publication affected commerce that is regulated by Congress cannot be used to show use of a service mark.
c. Exhibits 16 and 17 relate to an exchange of emails relating to pricing an ad. Exhibit 17 shows a superimposed heading with the Subject: Re: Cassa NYT classified. It is unclear where this excerpt came from. Regardless, at most, this Exhibit 17 shows a possible intent to advertise, and it does not constitute use of the mark in commerce, much less anything that can be attributed to Opposer. Exhibit 20 is an artwork that, at most, shows advertising of architectural services by Enrique Norten, an unrelated party (unless another oral license is alleged for these services). In any event, Opposer has not shown any technical use of the mark and, if it is, the use does not inure to its benefit.
d. Exhibit 21 is paper using the trade name Cassa Hotel and Residences as the term is preceded by "Managed by". And it points to an address and domain name

"cassahotelny.com" that are not parties to this action. To attribute the convoluted use of the designation "cassa" to Opposer from this paper is highly questionable.

e. Exhibit 23 purports to be an internet advertising. It mentions CASSA followed by an address. This exhibit was downloaded on January 13, 2014, after the filing date of the present application and it is thus irrelevant.
f. Exhibit 24, like Exhibit 23, was downloaded after Applicant's application filing date and it is thus irrelevant. Also, it refers to a third party, Cassa Hotel NY, and not to Opposer. There has been no verification that there is a license agreement between Opposer and this third party.
g. Exhibit 25, like the previous two exhibits, was downloaded after the filing date of the present application and it thus irrelevant. Also, there is a copyright notice claiming rights to versions that go from 2008 to 2014, clearly showing that the purported publication took place after 2013 and it is thus irrelevant.
h. Exhibit 26 is a screenshot dated 2014 and it is thus irrelevant. It includes an address so at most it refers to a trade name.
i. Exhibit 27 is likewise irrelevant for the purposes of demonstrating priority since it is dated 2015.
j. Exhibit 31 pertains to undated flyers. The Affiant has not indicated when they were distributed. Thus, they cannot be taken as showing use prior to Applicant's filing date

Therefore, the alleged continuous and uninterrupted use since 2009 is not supported by the contradictory evidence submitted in paragraph 11 of the affidavit.

In paragraph 12 of the affidavit, Opposer states that a final version of a brochure, Exhibit 34, was "published and commenced using it". Aff. ¶ 12. There is no description of how many brochures were printed nor how the "publication" took place. Regardless, there is no mention of ASSA Realty, LLC, the Opposer, in any of the brochures. In Bates No. AR0525 there is a reference to "Cassa" being an Assa Properties residential development. A development, or project, is different than a service mark.

The banners referred to in the affidavit as using the Mark do not correspond with the superimposed photograph included in Exhibit 28. Aff. ¶13. The photograph depicts a banner that includes the domain name "cassanyc.com" and a telephone number. This cannot be assumed to identify any services, hotel, residential sales or others. No relationship has been expressed between the parties in Exhibit 28 and the Opposer. The banners that include the designation Cassa were used before the services could be offered (hotel and residential services) therefore the display of the designation cannot identify a service being offered since the buildings were under construction. It is clear that Cassa was being used as the name of a project and not a service mark.

The use of the designation "CASSA NY" along with an address, 70 West Forty Fifth Street, indicates the location of a building and not an offer of services. Aff. ¶ 15.

The allegations in paragraph 16 are irrelevant for the issue of priority since the screenshots are dated after the filing date of the present application. Aff. ¶ 16.

The conclusion in paragraph 17 is not understood. A Google search in 2014 is not probative of any prior rights. Aff. ¶ 17.

The diagrams of a sales office, as alleged in paragraph 18, do not constitute evidence of use of a service mark. Exhibit 40. And the purported flyers do not identify the services nor the date or number sent to real estate agents specified. Aff. ¶ 18.

The purported license with Waterscape Resort, LLC alleged in paragraph 21 was ended with its bankruptcy. And the attempt to license another entity, Cassa Hotel NY, as alleged in ¶ 9 is tantamount to abandoning any mark rights that Opposer may have had since Waterscape Resort, LLC would no longer be capable of policing the mark as a licensor.

It is well established that an ITU applicant may rely on the constructive use provisions of the Lanham Act. *Zirco Corpo. V. AT&T, U.S.P.Q.2D (BNA) 1542, 1547 (TTAB 1991)*.

Therefore, only evidence of common law rights prior to the filing date of April 10, 2013 is relevant for the purposes of establishing priority.

The use of domain names in some internet email is not sufficient to establish use, or even use analogous to service mark use. *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 50 U.S.P.Q.2d 1545, 1555–56 (9th Cir. 1999). Opposer has not alleged a use analogous to service mark use. But, even if it were to allege such use, the unreasonable delay for more than two years until it allegedly started using the mark. See Aff. ¶5 alleging adoption in January, 2007. Nor, has there been even an allegation that an analogous use has any substantial impact in the public's mind. Rather, the allegations have been vague.

Lastly, the convoluted licensing (oral) agreement explanation for the use of the designation CASSA by different entities at different times raises, at the very least, genuine issues of material facts relating to standing. And whether the "licensed" mark, later "sub-licensed" at a bankruptcy proceeding casts a considerable doubt as to whether the Opposer maintained control over the runaway mark use by different entities. Such a duty of supervision derives from the Lanham Act's abandonment provisions, which specify that a registrant's mark may be canceled if the registrant fails to control its licensees' use of the licensed mark. *See, e.g.,* 15 U.S.C. § 1064(5)(A) (1988). *Mini Maid Services Co. v. Maid Brigade Systems, Inc.* F.2d 151623 U.S.P.Q.2d 1871 (11th Cir. 1992)

For the foregoing reasons, the assertions in the affidavit are not sufficient to show Opposer's prior rights and/or material issues of fact have been identified that prevent the granting of this motion.

Dated: August 13, 2015

Respectfully submitted,

/s/ Jesus Sanchelima

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing was mailed electronically by mutual agreement on this 13 day of August 2015 to:

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